

Serial No. 10/795,944
Reply dated June 23, 2005
Reply to Action dated May 12, 2005

REMARKS

This paper is filed in response to the Office Action dated May 12, 2005. As this paper is filed on June 23, 2005, the paper is timely filed.

I. Status of Amendments

Claims 14-26 were pending prior to this response. No amendments have been made. Consequently, claims 14-26 are presently pending.

II. Response to the May 12 Office Action

Claims 14-26 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, it is suggested that the limitations "biologically-active cellular units" and "matter" lack clear antecedent basis in the application as originally filed, and it is further suggested that pages 2-4 of the application are "drawn to the electroporation of waste-activated sludges containing intracellular and inter-cellular water, and the use of lysed cells as the food for the bioreactor." May 12 Office Action, at page 2. Claims 14-26 are also rejected under 35 U.S.C. 103 as allegedly unpatentable over Held et al. (U.S. Patent No. 6,491,820).

On June 13, 2005, the undersigned conducted a telephonic interview with the examiner. The undersigned and the examiner discussed both the Section 112 rejection and the Section 103 rejection. While no agreement was reached as to either issue, the examiner did agree to review applicants' comments and to consider the rejections in light of the applicants' comments. A presentation of applicants' comments follows.

At the outset, as was discussed during the interview, verbatim correspondence is not required between the written description and the claims. *In re Wright*, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("the claimed subject matter need not be described in *haec verba* in the specification in order for that specification to satisfy the description requirement"). Consequently, the claims cannot be rejected simply because neither of the specifically-cited limitations appears in the specification. If these limitations are supported in the specification, then the written description requirement is satisfied.

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As to the first limitation ("biologically-active cellular units"), applicants submit that this embraces all cellular units that are biologically-active (as opposed to biologically-inactive, which may include lysed cellular units). Applicants further note that, from the context of the claims, the biologically-active cellular units are found in the sludge ("sludge containing biologically-active cellular units") and may be found in the sludge prior to electroporation. Moreover, applicants note that, according to the specification, the material to be electroporated includes microorganisms from the bioreactor(s) (page 4, lines 14-20), as well as chemotrophs or autotrophs (page 4, lines 20-22). Consequently, applicants submit that this limitation is fully supported in the specification.

As to the second limitation ("matter"), from the context of the claims, "matter" is released from disrupted cellular units. The passage in the specification that bridges pages 3 and 4 states that the material treated by the electroporation device releases water (intracellular or inter-cellular) and "organic solids-contents." It is submitted that the limitation "matter" is supported by this disclosure, and that the written description requirement is satisfied.

As to the rejection under Section 103, applicants point out that "prior art" teachings relied upon (col. 10, line 42 through col. 11, line 46) are not prior art at all, but are teachings found in a common ancestor to the Held et al. patent and this application: U.S. Patent Application No. 09/612,776. Moreover, the '776 application is incorporated by reference into the present application. Furthermore, the '776 application, like the present application, supports the limitations "biologically-active cellular units" and "matter" (see, for example, the '776 application, page 4, line 16 through page 5, line 13, which corresponds in part to the passage from Held et al. relied upon in the May 12 Office Action). Consequently, applicants respectfully request that this rejection be withdrawn.

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In view of the remarks above, applicants believe the pending application is in condition for allowance. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. In any event, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 13-2855, under Order No. 30991/40225. A duplicate copy of this paper is enclosed.

Dated: June 23, 2005

Respectfully submitted,

By 
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